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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/751,310

01/02/2004

Gerhard Lengeling

P3252US1 (60108-0097)

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08/07/2006

HICKMAN PALERMO TROUNG & BECKER LLP
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EXAMINER

WARREN, DAVID S

ART UNIT

PAPER NUMBER

2837

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,310

Applicant(s)

LENGELING ET AL.

Examiner

David S. Warren

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 ~~1-228~~ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/2/04 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The “file structure” of claim 1 and its dependents and the “computer program” of claim 13 and its dependents have been held to be non-statutory subject matter. MPEP 2106 states that “[w]hen functional descriptive material [i.e., a file structure or computer program] is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” [Emphasis added]. The Applicant must add the structural limitation of the computer-readable medium to the claims to make claims 1 and 13 statutory.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 – 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite synthesis data and synthesis parameters. The specification only clearly defines synthesis parameters. However, the specification discusses, but makes no clear distinction between, synthesis parameters, synthesis data, synthesis instructions, and synthesis information (as well as user-defined synthesis parameters). There does not appear to be any clear definition of these terms. In the rejection below, the Examiner has treated data and parameters to be synonymous.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7, 9, 16, and 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 7 and 16, the Applicant distinguishes between synthesis data and MIDI data, however, from the claim language it appears that the synthesis data synthesizes the MIDI data. This appears to be contradictory to Applicant's specification. Regarding claims 9 and 18, the Applicant also distinguishes between playback data and MIDI data. However, claim 9 appears to state that playback data can render MIDI data. As with claim 7, this appears to be

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contradictory to Applicant's specification. The specification states only that users "may choose to change...a playback parameter or any other aspect of the audio data of a music piece" and that "the author may want to exchange audio data in a waveform data format...to allow a recipient of the audio data to manipulate the playback parameters."

[Emphasis added] The specification is completely silent as to how user-defined playback parameters are used to render MIDI.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 – 11, 13 – 20, and 22 – 28 are rejected under 35 U.S.C. 102(b) as being anticipated by (ACID User Manual; Sonic Foundry Europe. 1999) Regarding claims 1 and 13, the ACID Manual (hereafter, ACID) discloses the use of obtaining a set of waveform data (page 66; see *.wav and *.aif files), obtaining MIDI data (pages 16 - 19), obtaining synthesis data (pages 54 and 55; the Examiner notes that the Applicant has defined synthesis data as envelope data), obtaining playback data (pages 47 and 49; the Applicant has defined playback data as "emulating a desired ambiance" such as echo, i.e. effects) and combining these for storage and audio exchange (page 66; the *.acd files contain *all* the information about a project). Regarding claims 2 – 5 and 14,

ACID discloses the use of WAVE format and AIFF files (page 66) – these formats are sampled waveforms (ACID's manipulation of samples is deemed to be synonymous with synthesizing waveform data, i.e., creating new waveform patterns). Regarding claims 6 and 15, ACID discloses generating MIDI data (page 59). Regarding claims 7 and 16 (see §112 rejection supra), the ACID program can receive and respond to MIDI data: MIDI data is user-defined (e.g., a user of a MIDI program can define tempo, note-on and note-off events, pitch, timbre, etc.; see ACID pages 59 and 60). Regarding claims 8 and 17, ACID discloses the use of user-modification of synthesis data (as stated supra, the Applicant has defined "synthesis data" as being envelope data). It is noted that Applicant's specification is silent as to any "user-defined synthesis parameter" as well as "at least one synthesis modification parameter." The Examiner is interpreting this to mean users can modify envelope data, which is taught by ACID on pages 54 and 55. Regarding claims 9 and 18, (as best as can be understood, see §112 rejection supra), ACID can be controlled via a MIDI time code (i.e., a user-defined tempo control). Regarding claims 10 and 19, the Applicant has defined playback parameter as effects, ACID allows a user to control and set effects (see pages 47 and 49). Regarding claims 11 and 20, the ACID program uses (i.e., collects) all available data to construct a musical composition (i.e., "any available" data is deemed to be the data made available by the user). Regarding claims 22 – 28, all limitations have been discussed supra. The Examiner notes that the specification is silent as to any "audio instructions" and has therefore, interpreted these instructions to be synonymous with the synthesis data (since Applicant claims that the audio instructions are for

synthesizing the audio waveform). It is further noted that the synthesis parameters are, as above, interpreted as envelope data as defined by Applicant (the Applicant states "the characteristics of the envelope may be referred to as 'synthesis parameters' because that data sets forth the specific synthesis treatment used to process a given sound.")

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over ACID User's Manual (Sonic Foundry Europe. 1999) in view of Naples (6,924,425). The teachings the ACIC User's Manual (ACID) have been discussed supra. ACID does not disclose the use of chunking MIDI data. Naples discloses the use of storing MIDI (as well as audio) data in chunks (Figs. 2, 3A, and 3B; col. 7, lines 49 – 64). Naples, like ACID, also discloses the use of combining MIDI, audio, effects, and envelope data. It would have been obvious to one of ordinary skill in the art to combine the teachings of ACID and Naples to obtain a combination of MIDI and audio data with playback and synthesis data wherein the MIDI is stored in chunks. The motivation for making this combination is that most MIDI systems (e.g., sequencers, synthesizers, etc.) require

MIDI chunk header data (i.e., type, length) and the actual data (instructions) – the use of standard chunking protocol allows users to implement SMF systems and tools.

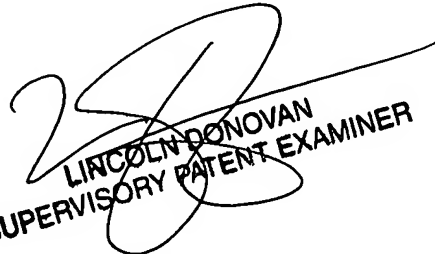
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Warren whose telephone number is 571-272-2076. The examiner can normally be reached on M-F, 9:30 A.M. to 6:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lincoln Donovan can be reached on 571-272-2837. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dsw


LINCOLN DONOVAN
SUPERVISORY PATENT EXAMINER